

REMARKS

The Examiner, Mr. Borissov, is thanked for the courtesy extended Applicants attorney during the interview of August 18, 2004 wherein, as indicated in the interview summary, the applicability of the prior art was discussed, the proposed amendment was discussed and the Examiner indicated that to address the content of attribute data a new search is required. In light of the position set forth by the Examiner, this amendment is being filed together with an RCE in response to the Office Action dated April 20, 2004 in order to obtain proper consideration of the claimed features.

The Examiners indication that claims 14 and 15 are objected to and would be allowable if rewritten in independent form including all of the limitations of base claim and any intervening claims is acknowledged, being note that such claims have been retained in dependent form at this time and that Applicants note that dependent claim 7 is coextensive with the features of the dependent claim 14 and any distinction with respect thereto is not understood.

With regard to the claim objections and the rejections under 35 U.S.C. §112, second paragraph, Applicants submit that by the present amendment of the claims, the objections and rejections noted by the Examiner have been overcome and that all claims should be considered to be in compliance with 35 U.S.C. §112.

At the outset, Applicants note that the present invention is directed to a system and method in which energy-saving equipment is installed in a facility so as to reduce energy consumption and in which a portion of the reduction in energy cost may be provided to the provider of the energy-saving equipment. Applicants note that while prior art arrangements may be considered to disclose the providing of energy-saving equipment the prior art fails to provide an accurate system or method for comparing energy consumption prior to taking the energy-saving measures with that energy consumption after taking the energy-saving measures. That is, the prior

art generally provides a measurement or stores data of energy consumption prior to taking the energy-saving measures so as to provide a base line or the like for comparison and then compares the energy-consumption data which is measured after taking the energy-saving measures with such base line.

In accordance with the present invention, at least specified attribute data of a variable characteristic of energy consumption is also obtained, which attribute data, as described under (step S35) at page 24 of the specification, for example, include temperature, humidity and operating conditions such a production quantity, batch processing frequency, and the like. By the present amendment, each of the independent claims of this application of claims 2, 8, 10 and 17 recite that feature of obtaining past data of energy consumption of equipment of a facility before taking energy-saving measures by installing energy-saving equipment is correlated with attribute data of a variable characteristic of the energy consumption of the equipment of the facility which includes at least one of temperature, humidity and an operating condition including at least one of a production quantity and a frequency of batch processing which data is stored in the database, and after taking energy-saving measures by installing energy-saving equipment, present data of the energy consumption of the energy-saving equipment of the facility is measured together with the attribute data, which attribute data as recited in the claims includes at least one of temperature, humidity and an operating condition including at least one of production quantity and a frequency of batch processing, with the measured present data and the stored past data having the attribute data within an allowable range being compared to calculate the energy curtailment quantities. Thus, the stored data and the present measured data correlated with the attribute data are compared to obtain an accurate determination of the energy curtailment quantities and Applicants submit that the recited features of each of the independent claims of this application and therewith the dependent claims are not disclosed or taught in the cited art.

As to the rejection of claims 8, 10-12 and 17-22 under 35 U.S.C. §102(a) as being anticipated by Yablanowski et al. (US 6,535,859) and rejection claims 2-7, 13 and 24-25 under 35 U.S.C. §103(a) as being unpatentable over Yablanowski et al., such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. §102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 U.S.C. §103 reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of

the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Irrespective of the position of the Examiner concerning the disclosure of the Yablonowski et al., Applicants note that Yablonowski et al. only discloses a lighting

system as a service facility for energy saving wherein an original power consumption of the facility is determined before the lighting system is retrofitted with at least one power saving device and after the lighting system is retro-fitted with at least one power saving device, a new power consumption is measured of the facility with fee being charged based upon a function of a difference between the original power consumption and the new power consumption. Applicants submit that while Yablonowski et al. discuss the possibility of taking hours of operation of the system into effect, Yablonowski et al. do not disclose in the sense of 35 U.S.C. §102 or teach in the sense of 35 U.S.C. §103 as recited in independent claim 2 and corresponding recited in the other independent claims of this application “wherein said past data in said database are stored in a form correlated with attribute data of a variable characteristic of the energy consumption of said equipment of said facility before taking the energy-saving measures which includes at least one of temperature, humidity and an operating condition including at least one of a production quantity and a frequency of batch processing; wherein said measuring means measure said present data of said energy-saving equipment of said facility together with said attribute data; and wherein said calculating means retrieve said past data having said attribute data within a set allowable range corresponding to said measured present data having said attribute data for said energy-saving equipment of said facility, and calculates the energy curtailment quantities by comparing said retrieved past data having said attribute data and said measured present data having said attribute data”. Applicants submit that Yablonowski et al. fails to disclose obtaining attribute data as recited and comparing the past data with the present measure data taking into consideration the attribute data, as recited.

Applicants submit that such recited features of the claims whether directed to an energy service business system or an energy service business method can not be ignored and represent limitations of the system and method as claimed. Thus, Applicants submit that each of the independent claims of this application not only distinguish over Yablonowski et al. in the sense of 35 U.S.C. §102 and 35 U.S.C. §103 and should be considered allowable thereover.

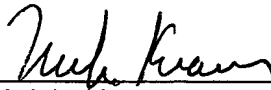
As to the dependent claims, Applicants note that the Examiner has recognized the patentability of claims 14 and 15 in relation to the method, but for some reason ignores the limitation of claim 7 which corresponds to claim 14 in relation to the system. As noted above, irrespective of whether a system or method is claimed, the features thereof cannot be ignored and Applicants submit that the Examiner has recognized that Yablonowski et al. does not disclose or teach the features of claim 14 and similarly, Yablonowski et al. do not disclose or teach the features of claim 7. As to the other dependent claims, Applicants submit that such claims recite further features not disclosed or taught by Yablonowski et al. such that Applicants submit that all claims of the this application patentably distinguish thereover and should be considered allowable at this time.

As pointed out at the interview, the present application is related to another application assigned to the assignee of the present application, U.S. Application Serial No. 09/661,373 which has issued as U.S. Patent No. 6,775,595, a copy of which is submitted herewith. Also submitted herewith an Information Disclosure Statement listing other cited art cited in such application and not considered herein.

For the foregoing reasons, Applicants submit that all claims present in this application should now be in condition for allowance. An issuance of an action of favorable nature is courtesy solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (389.40083X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Melvin Kraus', is written over a horizontal line.

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